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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,368	11/29/2000	Gregory J. Gagnon	PD-990271	5293

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THE DIRECTV GROUP INC
PATENT DOCKET ADMINISTRATION RE/R11/A109
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EXAMINER

THOMPSON JR, FOREST

ART UNIT PAPER NUMBER

3625

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/726,368

Applicant(s)

GAGNON ET AL.

Examiner

Forest Thompson Jr.

Art Unit

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WJ

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-20,23-35 and 38-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-20,23-35 and 38-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Conclusion

DETAILED ACTION

Response to Amendment

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action (See Paper #2). The text of those sections of Title 35, U.S. Code not otherwise provided in a prior Office action will be included in this action where appropriate.
2. This action is responsive to amendment A filed on 03/03/2004 (see Paper #4). Applicant amended claims 1-5, 16-20, and 31-35, cancelled claims 6-7, 21-22, and 36-37, and added new claims 46-52. Claims 1-5, 8-20, 23-35, and 38-52 are pending.
3. Claims 1-5, 8-20, 23-35, and 38-52 have been examined.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 states, "programming package the receiver" at line 10. This should be changed to read "programming package for the receiver" for clarity.

For purposes of expediting prosecution of the application, examiner has examined the claim on the basis of this proposed change. Correction is required.

Claim Rejections - 35 USC § 102

6. Claims 1-5, 8-20, 23-35, and 38-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Nel (U.S. Patent No. 6,363,364).

Claims 1, 16, 31: Nel teaches:

- activating, in a receiver connected to a presentation device, a purchase screen having at least one field (col. 2 line 66 – col. 4 line 23);
- receive broadcast signals through an input mechanism (col. 3 lines 3-11); and
- enable the presentation device to display the broadcast signals (col. 3 lines 3-11);
- the activation enabling the purchase screen to be displayed on the presentation device (col. 2 line 66 – col. 4 line 23);
- receiving purchase information in the at least one field into the receiver from a user (col. 4 lines 16-23);
- establishing a secure electronic connection, using a communication mechanism of the receiver that is different from the input mechanism, with a vendor (col. 3 lines 41-57);
- electronically transmitting the purchase information from the receiver through the secure electronic connection to the vendor (col. 3 lines 41-51; col. 4 lines 4-15);

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- receiving a confirmation number from the vendor into the receiver (col. 3 lines 52-57);
- receiving, in the receiver, authorization for the initial activation of the subscription television service from the vendor (col. 3 line 3 – col. 4 line 55); and
- configuring the receiver to allow the display of the subscription television services (col. 3 line 3 – col. 4 line 55).
- wherein the purchase information identifies an initial television subscription service for an initial activation of the receiver and a television programming package for the receiver (col. 3 lines 41-51), as inferred by the teaching that *The system includes security mechanisms to ensure that only an authorised user can gain access to information relating to certain accounts. Such measures normally include account numbers and a personal identity number (PIN) transmitted from the instruments 20, 24 to the network 28 via network 22. Similarly, security measures are utilized to ensure that the requested data is only displayed on an authorized monitor 12. These measures may include an identification (ID) code number accompanying the data in the signal and which ID code enables only a designated decoder 14 to decode the encoded data in the signal.* This teaching infers that users must have registered/subscribed through some means in order to use the invention as per the teaching that the security mechanisms restrict access to only users who are authorized, which encompasses applicants' claim language of *an initial television subscription service for an initial activation.*

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Claims 2, 17, 32: Nel teaches the activation of the purchase screen is received from a user using a remote control (col. 6 line 42 – col. 7 line 24).

Claims 3, 18, 33: Nel does not explicitly disclose the purchase information comprising a type of credit card; a credit card number; and an expiration date. However, Nel does disclose:

- a smart card (a type of card that provides the functionality and characteristics of a credit card, and additionally other desirable characteristics/capabilities) (col. 4 line 59 – col. 5 line 43); and
- The computer network has a first financial institution 112 and a second institution 114 with computer based client accounts held within a said first financial institution database 113 and a second financial institution database 115. The system allows users to access and manipulate at least one account held at said financial institution and transfer funds between accounts held by said first financial institution 112 and a second institution 114 by making a desired selection or input on at least one or more of the following input means; a keypad or keyboard 101, a remote control 102 or a telephone instrument such as a tone 110 or cellular phone 111 that is displayed on display means such as a television screen or computer monitor 100. (col. 4 line 59 – col. 5 line 4) This encompasses purchase information comprising a type of credit card with a credit card number and an expiration date issued to a user by a financial institution for use by the user to make purchases or pay debts.

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Claims 4, 19, 34: Nel teaches the additional purchase information comprises merchandise information for merchandise to be purchased from the vendor (col. 6 line 42 – col. 7 line 24).

Claims 5, 20, 35: Nel teaches receiving additional purchase information, wherein the additional purchase information comprises service information for a service to be purchased from the vendor (col. 6 line 42 – col. 7 line 24).

Claim 6. (CANCELED)

Claim 7. (CANCELED)

Claims 8, 23, 38: Nel teaches receiving, in the receiver, authorization for the service from the vendor; and configuring the receiver to allow the display of the authorized services (col. 3 line 3 – col. 4 line 55).

Claims 9, 24, 39: Nel teaches verifying that all of the required purchase information has been received (col. 3 lines 52-57).

Claims 10, 25, 40: Nel teaches:

- obtaining a dialtone through a modem connected to the receiver, and dialing a phone number corresponding to the vendor selected, wherein the phone number is stored in the receiver (col. 5 lines 57-67), as taught in the disclosure *Selections are communicated to a computer network of a vendor through the decoder 120 via a telephone network that may include the use of a modem or via RF signals by means of a receiver and transmitter 125 and 129 at user base and at the broadcaster or via bi-directional satellite 127 communication through a satellite dish at user base 126.*

Alternatively a normal phone 130 or a cellular phone 131 or satellite phone may link to an IVR (Interactive voice response system) 132 which may serve as a frontend to communicate user selections or inputs to the computer network of said vendor computer network 134.

- establishing a secure connection with a computer system of the vendor at the phone number dialed (col. 3 lines 41-51; col. 5 lines 48-67).

Claims 11, 26, 41: Nel teaches causing one or more onscreen messages to be displayed that indicate actions being taken by the receiver (Abstract).

Claims 12, 27, 42: Nel does not explicitly teach storing the confirmation number into a purchase history screen in the receiver that allows a customer to view the purchase information. Nel does teach confirmation of the selected instruction, data requested and account balances are visually displayed in real time on the monitor (col. 3 lines 52-57), which encompasses applicant's claimed aspect. Nel's teaching encompasses the use of a confirmation number to identify a selected instruction, data requested and account balance.

Claims 13, 28, 43: Nel does not explicitly disclose the vendor is a credit card company. However, Nel does disclose a system including:

- a computer network of at least one vendor (Abstract);
- Financial transactions could include banking transactions such as balance requests, funds transfer transactions, electronic account payment transactions and

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purchase transactions with vendors and/or service providers connected to the network (col. 1 lines 45-49);

- The computer network has a first financial institution 112 and a second institution 114 with computer based client accounts held within a said first financial institution database 113 and a second financial institution database 115. The system allows users to access and manipulate at least one account held at said financial institution and transfer funds between accounts held by said first financial institution 112 and a second institution 114 by making a desired selection or input on at least one or more of the following input means; a keypad or keyboard 101, a remote control 102 or a telephone instrument such as a tone 110 or cellular phone 111 that is displayed on display means such as a television screen or computer monitor 100. (col. 4 line 59 – col. 5 line 4) This encompasses a credit card account issued to a user by a financial institution for use by the user to make purchases or pay debts

- Further services include account payments, funds transfers, managing debit orders, account viewing, account management, etc. Also product based financial functions such as shares, mutual funds, futures and the like may be done via the said system. (col. 5 lines 28-33)

- a system for performing a commercial transaction or function through a vendor network for accessing a product or service that may be held at a vendor database (fig. 5 [120, 122, 134, 135, 136]);

- Also linked to said computer network may include a financial institution 137 for example a bank and a service provider 138. Furthermore a storage device reader

and/or writer for example a smart card reader 124 internally to the decoder (not shown) or externally connected via a communications port such as a RS232 port may allow for payment or uploading and downloading of funds onto a smart card. Of course the vendor and the financial institution may be the same institution. The second account may be held by a vendor or service provider or third party at the financial institution to allow bill payments or for real time accounting and payment of users selected products of 15; services. The smart card may in conjunction with the PIN be used for user identification and the encryption and decryption communicated from the financial institution or vendor to the smart card and vice versa. (col. 6 lines 3-19).

In the above teaching, Nel teaches an account held by a user at a financial institution that may be used to collect or disburse funds. The above teaching encompasses a credit card account issued to a user by a financial institution for use by the user to make purchases or pay debts, and the user receiving confirmation indications and or identifiers of his transactions. Additionally, a smart card is taught by Nel in the above disclosure, which is "a type of credit card", as claimed by applicant. Therefore, the teaching encompasses applicant's claimed inventive aspect of a vendor is a credit card company.

Claims 14, 29, 44: Nel discloses the receiver is an integrated receiver/decoder (IRD) (fig. 1 [14]).

Claims 15, 30, 45: Nel discloses the presentation device is a television (col. 5 lines 48-57).

Claim 21. (CANCELED)

Claim 22. (CANCELED)

Claim 36. (CANCELED)

Claim 37. (CANCELED)

49. Claim 49 is a method and contains the same limitations as the combination of claims 1-3 or 16-18 or 31-33; therefore, the same rejection is applied.

50. Claim 50 is a method and contains essentially the same limitations as claims 12 and 13; therefore, the same rejection is applied.

52. Claim 52 is a method and contains essentially the same limitation as claim 1 or 16 or 30; therefore, the same rejection is applied.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 46, 47, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nel as applied to claims 1, 16 and 30 above, and further in view of Metz et al. (U.S. Patent no. 5,978,855).

Claims 46, 47, 48: Nel does not explicitly teach all of the steps are automated without interacting with personnel from the vendor; the receiver is configured to perform the actions automatically without interacting with personnel from the vendor; nor all of the means automatically perform the indicated actions without interacting with personnel from the vendor. However, Metz et al. does teach all of the steps are automated without interacting with personnel from the vendor; the receiver is configured to perform the actions automatically without interacting with personnel from the vendor; and all of the means automatically perform the indicated actions without interacting with personnel from the vendor (col. 35 line 60 – col. 38 line 11). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the teaching of Nel to explicitly automate all of the steps without interacting with personnel from the vendor; configure the receiver to perform the actions automatically without interacting with personnel from the vendor; and automatically perform the indicated actions without interacting with personnel from the vendor, as taught by Metz et al., for

the motivation of initializing a subscription television service in an efficient and cost effective manner.

10. Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nel as applied to claims 1, 16 and 30 above, and further in view of Koreeda et al. (U.S. Patent No. 5,890,137).

51. Nel does not explicitly teach the vendor is a credit card company, nor the vendor notifies a service provider of a credit card transaction and the good or service purchased to provide the good or service to the user. However, Koreeda teaches the vendor is a credit card company, and the vendor notifies a service provider of a credit card transaction and the good or service purchased to provide the good or service to the user (Abstract). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the invention of Nel to explicitly teach the vendor is a credit card company, and the vendor notifies a service provider of a credit card transaction and the good or service purchased to provide the good or service to the user, as taught by Koreeda, for the motivation of making and settling a purchase.

Response to Arguments

11. Applicant's arguments with respect to claims 1-5, 8-20, 23-35, and 38-52 have been considered but are moot in view of the new ground(s) of rejection. Additionally,

with respect to some of applicants' arguments, a specific response has been provided, for completeness.

Applicants argue, at pg. 13 that Nel fails to teach, disclose or suggest the initial activation of a subscription television service.

Examiner disagrees. See the rejection of claim 1 above. Examiner maintains the rejection.

Applicants argue, at pg. 13, that Nel fails to teach, disclose or suggest the automated initial activation of a subscription television service without the interaction with vendor personnel.

Examiner disagrees. See the rejection of claims 46-48, above. Examiner has rejected these claims above and identified specific references.

Applicants argue, at pg. 13, that Nel fails to teach, disclose or suggest the use of a credit card or conducting a credit card transaction.

Examiner disagrees. Examiner has identified the prior art passage that encompasses this aspect of applicants' invention in the rejection of claims 3, 18, 33. Therefore, examiner maintains the rejection.

Applicants argue, at pg. 13, that Nel fails to teach, disclose or suggest displaying a history of purchases.

Examiner disagrees. Nel teaches confirmation of the selected instruction, data requested and account balances are visually displayed in real time on the monitor (col. 3 lines 52-57), which encompasses applicant's claimed aspect, i.e., the confirmation requires access to a database in order to visually display, e.g., account balances. This confirmation must access history information, i.e., data stored in a database, which encompasses applicants' claimed aspect. Therefore, examiner maintains the rejection.

Conclusion


12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

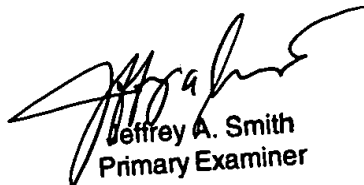
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest Thompson Jr. whose telephone number is (703) 306-5449. The examiner can normally be reached on 6:30 AM-3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FT 
05/11/2004


Jeffrey A. Smith
Primary Examiner

Claim Tree

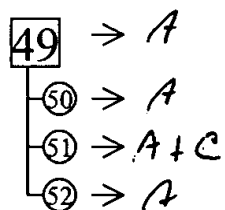
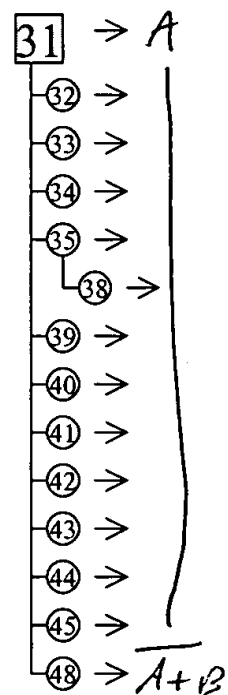
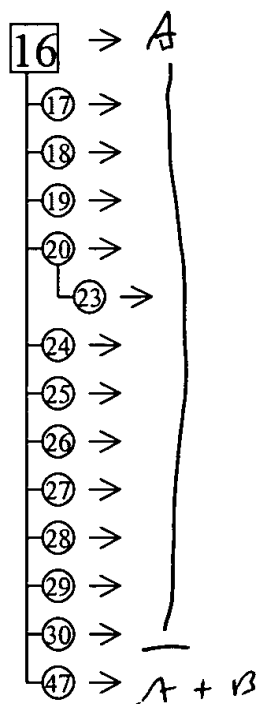
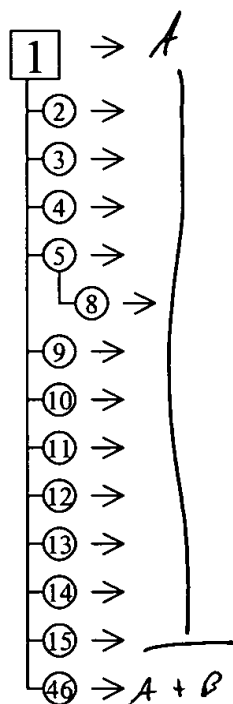
References:

A -6,363,364

B -5,978,855

C-5,890,137

ON - Official Notice



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>>Independent Claims